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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,512	11/09/2001	Richard W. Cruse	1302-66 (US1430061-15)	5540
43246	7590	11/28/2005	EXAMINER	
GEAM - SILICONES - 60SI IP LEGAL ONE PLASTICS AVENUE PITTSFIELD, MA 01201-3697			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,512

Applicant(s)

CRUSE ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 4,16,19,23,36 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-15,17,18,20-22,24-35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1201,0202 & 0402</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the following genii of the claimed invention:

A) For the first Genii.

- a. wherein the blocked mercaptosilane is as in claims 3 and 22.
- b. wherein the blocked mercaptosilane is as in claims 4, 19, 23 and 38.

B) For the second Genii.

- a. wherein the G is a substituted phenyl group (claims 16 and 36).
- b. wherein the G is a substituted alkyl group (claims 17, 18 and 37).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Peter G. Dilworth on 11/16/05, a provisional election was made with traverse to prosecute the invention of species A) a and B) b, claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4, 16, 19, 23, 36 and 38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are rejected under 35

U.S.C. 102(b) as being anticipated by Bomal et al. (AU-A-10082/97)

In page 8, lines 6-10 and page 30, line 1 to page 33, line 10, Bomal et al. teach rubber compositions comprising, at least one elastomer (rubber), a filler and a blocked mercaptosilanes represented by formulas (1) or (2) in applicant's presently claimed invention.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

3. Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are rejected under 35

U.S.C. 102(b) as being anticipated by Takeshita et al. (USPN 4,820,751)

In col. 2, lines 42-59, col. 3, lines 1-15 and Table 2, Takeshita et al. teach a rubber composition comprising an organic polymer, a filler, and blocked mercaptosilanes represented by formulas (1) or (2) in applicant's presently claimed invention.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

4. Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Bell et al. (USPN 3,922,436)

In col. 1, lines 64-69 and col. 5 and 6, Bell et al. teach a rubber composition comprising an organic polymer, a filler, and blocked mercaptosilanes represented by formulas (1) or (2) in applicant's presently claimed invention.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

5. Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Seiler et al. (USPN 4,060,539)

In col. 1, lines 7-65 and col. 3, lines 63-67, Seiler et al. teach polymeric compositions comprising organic polymers, fillers, and blocked mercaptosilanes represented by formulas (1) or (2) of applicant's presently claimed invention, said blocked mercaptosilanes being produced from the reaction between a mercaptosilane and a monoacid anhydride corresponding to the thioester group present in the desired product.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-32 of copending Application No. 09/986,515 or claims 8-24 and 33-38 of copending Application No. 09/986,514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions claimed in 09/986,515 or 09/986,514 cannot be practiced without infringing on the presently claimed composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,127,468 or claims 1, 2 and 6 of U.S. Patent No. 6,204,339. Although the conflicting claims are not identical, they are not patentably distinct from each other because, the process of 6,127,468 cannot be practiced without the claimed composition and the composition of 6,204,339 requires the presently claimed composition comprising the presently claimed blocked mercaptosilane as a subcomponent, wherein the substrate for the mercaptosilane is a filler.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE



KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER